

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

Rejections Under 35 U.S.C. § 103

Claims 1, 3-10, 11, 13-20 and 22-30

In Section 4.1 of the Office Action, Claims 1, 3-10, 11, 13-20 and 22-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent Publication No. 2001/0042020 (Schachne et al.) and further in view of U.S. Patent No. 6,167,383 (Henson). Applicant reserves the right to swear behind both Schachne and Henson. Applicant respectfully traverses the rejection. Neither Schachne nor Henson alone or in combination disclose, teach, or suggest the claimed invention as recited in claims 1-30.

In response to Applicant's Amendment and Reply filed March 28, 2005, the Examiner makes two arguments. Applicant respectfully asserts that the Examiner has failed to provide sufficient evidence to support his positions.

First, the Examiner contends that Henson teaches "displaying at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the primary product or service, the at least one secondary product or service being displayed with the primary product or service in response to the request," required by the rejected claims. (See page 2, Final Office Action.)

However, Henson does not describe or suggest that the speakers, storage products, bundled software, scanners, etc. are associated with the Dell Dimension XPS and displayed in response to the request indicating the primary product or service. Henson only describes customizing a product. There is no discussion or suggestion that the options provided to the user are different depending on the particular primary product selected. The Examiner argues that these configuration options are not "integral" to the primary product (the computer) or "essential

components” needed for the primary product to work. The Examiner’s implication is that because the configuration options in Henson are not “integral” or “essential components,” they are “secondary products.” Nevertheless, whether or not the products are “integral” or “essential components” has nothing to do with displaying associated products in response to a request for a primary product. Henson clearly indicates that the configuration options presented to the user may not be appropriate for the primary product. Henson states:

The on-line store further includes validation of a configuration built by a customer. Validation (or compatibility) provides the customer with a validation message indicating an occurrence of **when the options selected for a particular system are not correct**. If the options selected for a particular system will adversely affect the shipment of the configured system, then a warning message is issued to enable the user to modify options accordingly. In other words, the validation enhancement lets the customer know when one or more options are not compatible for one reason or another.

(Henson, col. 7, lines 57-67, emphasis added.)

Henson does not display “secondary products associated with the primary product” in response to the request for the primary product. As the quoted passage indicates, if the displayed options “are not compatible” or may not work for the requested primary product, Henson provides a “warning” to the user. If the configuration options may not be valid or compatible with the primary product, the displayed options are not “associated with” and/or the requested primary product, as required by the rejected claims,

Second, the Examiner contends that Schachne et al. does not teach away from “displaying at least one secondary product or service associated with the primary product or service utilizing the network prior to providing a purchase order for the primary product or service, the at least one secondary product or service being displayed with the primary product or service in response to the request,” required by the rejected claims. (See page 3, Final Office Action.)

Applicant respectfully disagrees. The rejected claims require the display of a secondary product or service “prior to providing a purchase order for the primary product or service.” Schachne et al. clearly describes a process in which a user is presented with the “order form” of Fig. 2 requiring that the “customer enter sufficient customer information for the business transaction to transpire.” (Schachne et al., para. [0019].) Once the order form is completed, an offer to enter a second business transaction is presented. The system in Schachne et al. does not display a secondary product if the order form of Fig. 2 is not completed. The Federal Circuit has held:

A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.

In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

Here, Schachne et al. is teaching that a order form (Fig. 2) should be provided and completed by the user before a second product or business opportunity is presented. As such, not only does Schachne et al. teach not to display secondary products prior to **providing** a purchase order (as recited in the rejected claims), but Schachne et al. also teaches not to display the secondary products until after the purchase order is sufficiently **completed** by the user.

Finally, in light of these differences between Schachne et al. and Henson, it should be clear that there is not a motivation or suggestion to combine the two transaction system of Schachne et al. with the configuration system of Henson. A person of skill in the art would not take a system that obtains purchase order information before presenting additional products to sell (Schachne et al.) with a system that confirms that the configuration options selected by a user will work with the requested primary product before checking out and placing the order (Henson). The Examiner points to paragraph [0005] of Schachne et al. for the suggestion to combine with Henson. However, paragraph [0005] teaches “not requiring further input from the customer...to entice the customer to accept the offer due to the simplicity of the operation.” This

teaching is contrary to “displaying at least one secondary product or service...prior to providing a purchase order for the primary product or service,” as required by the rejected claims.

For at least the reasons above, Applicant respectfully requests the withdrawal of the rejection.

Claims 2, 12 and 21

In Section 4.2 of the Office Action, Claims 2, 12 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schachne et al. in view of Henson and further in view of U.S. Patent 6,167,382 (Sparks). Applicant reserves the right to swear behind Sparks. Applicant traverses this rejection and respectfully submits that claims 2, 12, and 21 are allowable for at least the reasons outlined above relative to claims 1, 11, and 20.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2350. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2350. If any extensions of time are needed for timely acceptance of papers submitted herewith,

Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2350.

Respectfully submitted,

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